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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,313	04/25/2000	Amit D. Agarwal	249768020US1	9641

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EXAMINER	
JAKETIC, BRYAN J	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/558,313	AGARWAL, AMIT D.	
	Examiner	Art Unit	
	Bryan Jaketic	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,960,411 (Hereafter 'Hartman') in view of Kenney. Claim 1 of Hartman claims the step of "in response to only a single action being performed, sending a request to order the item". Hartman does not teach the steps of automatically initiating the replenishment of a consumable product. Kenney teaches a method in a data processing system for automatically initiating the replenishment of a consumable product comprising the steps of receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines 12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). The consumer then requests replenishment of the product by

performing an interaction, and the product is ordered (Fig. 10A). The target date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory and a computer-readable medium containing instructions for carrying out the method.

Neither Hartman nor Kenney disclose the date on which the system provides the indication to the consumer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an indication to the consumer on or before the target date, so the consumer will not run out of the item.

The items being sold in Hartman and Kenney are physical articles. Neither Hartman nor Kenney teach the step of selling data products or services. However, the type of item being sold does not alter how the system functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the combination of Hartman and Kenney to sell any type of item or service because the type of item does not patentably distinguish the claimed invention.

Neither Hartman nor Kenney teach the step of determining a target date based on availability of an item. However, it is common in the art to only suggest the purchase of an item if that item is in stock. It therefore would have been obvious to one of

ordinary skill in the art at the time the invention was made to use the availability of the item to determine a target date so that the indication is sent only if the item is available.

Neither Hartman nor Kenney teach the step of determining a target date based on the size of the item. However, it is commonly known in the art that the size of an item will impact the length of time it takes to consume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine a target date based on the size of the item, so that a more accurate date is determined.

Neither Hartman nor Kenney teach the step of determining a target date base on an expiration date. However, it is commonly known in the art that items need to be replaced after they expire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ to determine a target date based on an expiration date so that a customer will replace expired items.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney in view of *Amazon.com, Inc. v. BarnesAndNoble.com, Inc.*, 239 F.3d 1343, 57 USPQ 1747 (Fed. Cir. 2001) (Hereafter "Amazon"). Kenney discloses a method in a data processing system for automatically initiating the replenishment of a consumable product comprising the steps of receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines

12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). The consumer then requests replenishment of the product by performing an interaction, and the product is ordered (Fig. 10A). The target date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory and a computer-readable medium containing instructions for carrying out the method.

Kenney does not disclose the date on which the system provides the indication to the consumer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an indication to the consumer on or before the target date, so the consumer will not run out of the item.

The items being sold in Kenney are physical articles. However, the type of item being sold does not alter how the system functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the system of Kenney to sell any type of item because the type of item does not patentably distinguish the claimed invention.

Kenney does not teach the step of determining a target date based on availability of an item. However, it is common in the art to only suggest the purchase of an item if

that item is in stock. It therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to use the availability of the item to determine a target date so that the indication is sent only if the item is available.

Kenney does not teach the step of determining a target date based on the size of the item. However, it is commonly known in the art that the size of an item will impact the length of time it takes to consume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine a target date based on the size of the item, so that a more accurate date is determined.

Kenney does not teach the step of determining a target date base on an expiration date. However, it is commonly known in the art that items need to be replaced after they expire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ to determine a target date based on an expiration date so that a customer will replace expired items.

Kenney does not teach the step of requesting replenishment of the product by performing a single action. Amazon.com discusses the CompuServe Trend System, developed in the mid-1990's (see pp. 15-17). The CompuServe Trend System required only a single action to obtain fulfillment of an order (see p. 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Amazon.com with the invention of Kenney to allow users to order an item by performing a single action, for the convenience of the customer.

5. Claims 36-38, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney. Kenney teaches a data processing system for automatically

initiating the replenishment of a consumable product comprising: receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines 12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). A reorder date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory, data structures, and a computer-readable medium containing instructions for carrying out the method.

Kenney does not teach the step of storing a target date on which the replenishment of the item is to be proposed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of storing a target date for proposing replenishment of the item to ensure that the consumer is notified when the item needs to be replenished.

6. Claims 27-35 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney as applied to claims 36-38 and 41-44 above, and further in view of Feinleib. Kenney teaches all of the limitations of the claims except for the step of scheduling a time for transmission of a unilateral transmission indicating that the item should be purchased. Feinleib discloses a reminder system that sends email reminders at a specified time prior to an event occurrence. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the reminder system of Feinleib with the invention of Kenney to send timely reminders to users via

email, voice mail, or instant message, regardless of whether they are engaged in electronic shopping, to ensure that customers are aware of an upcoming event.

7. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney as applied to claims 36-38, and 41-44 above, and further in view of Roden et al. Kenney teaches all of the limitations of the claims, except for a teaching that the product is automatically ordered. Roden et al disclose a method for automatically re-ordering needed inventory (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Manchala et al with the invention of Kenney to ensure that products are ordered in a timely fashion.

Response to Arguments

8. Applicant's arguments filed 7 November 2003 have been fully considered but they are not persuasive. Applicant argues that Kenney fails to disclose a user interface control. Examiner respectfully disagrees and maintains that the local computer (20a, ..., 20n) constitutes a user interface control usable by the consumer to request replenishment of the first item.

Regarding claims 36-38, Applicant argues that it is not inherent that Kenney uses a data structure comprising a plurality of entries. Examiner respectfully disagrees, and maintains that data structures are inherent to the teachings of Kenney. Applicant further argues that Kenney does not teach the step of storing a target date as an entry in a data structure. Examiner maintains that it would have been obvious to one of ordinary skill in

the art at the time the invention was made to employ the step of storing a target date to ensure that the consumer is notified when the item needs to be reordered.

Regarding claim 41, Applicant argues that the step of raising an event is not inherent to Kenney. Examiner respectfully disagrees. Kenney teaches the step of notifying a consumer of products that need to be reordered (col. 12, lines 50-54). It is inherent that an event must be raised to perform this step.

Regarding claims 27-35 and 45-47, applicant argues that there is no motivation to combine the teachings of Kenney and Feinleib. Examiner respectfully disagrees. Feinleib discloses a reminder system that notifies users of upcoming events. Examiner maintains that this is sufficient motivation to employ the system of Feinleib to notify users of the need to reorder items.

9. Applicant's arguments with respect to claims 1-27, 39, 40, and 44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj

1/26/04